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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,264	02/15/2001	Peng Cho Tang	038602-1086	9846

7590

04/22/2002

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 04/22/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on April 3, 2002  
☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~on the day~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

☒ Claim(s) 1-60 are pending in the application.  
Of the above, claim(s) 9, 12, 15, 16, 26-29, 35, 37, 43, 45, 47 and 52-59 are withdrawn from consideration.  
☐ Claim(s) \_\_\_\_\_ is/are allowed.  
☒ Claim(s) 1, 2, 8, 10, 11, 14, 25, 30, 33, 36, 40, 41, 46 and 50 are rejected.  
☒ Claim(s) 3-7, 13, 17-19, 31, 32, 34, 37, 38, 42, 44, 48, 49 and 51 are objected to.  
☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

☒ Notice of Reference Cited, PTO-892  
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 1 and 8  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING PAGES--

## DETAILED ACTION

Claims 1-60 are pending in the application.

### *Election/Restrictions*

Applicants' election with traverse of Group I in Paper No. 10 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the Examiner to examine Groups I and II together.

Applicants' argument has been considered but has not been found persuasive. Section 121 provides the Commissioner of Patents and Trademarks with the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. In the instant application, the Examiner has determined that several independent and distinct inventions are claimed in the application. Separate search considerations are involved if Groups I and II were to be examined together. Therefore, it would impose undue burden to the Examiner and the Patent Office's resources to examine the inventions of Group I and Group II in a single application.

The requirement is still deemed proper and is therefore made  
FINAL.

The generic concept, inclusive of the elected species of Example 80  
on page 131, which has been examined is as follows:

Compounds of Formula (I) wherein

$R^6$  is  $-C(=O)R^{10}$  ;

$R^{10}$  is  $-N(R^{11})(CH_2)_nR^{12}$  ;

$R^{12}$  is  $NR^{13}R^{14}$  ;

$R^{13}$  and  $R^{14}$  do not combine to form a ring.

Support for this generic concept can be find in the instant specification  
on page 53, lines 22-26 and page 54, lines 1-4.

Subject matter not embraced by the above identified generic  
concept and claims 9, 12, 15, 16, 20-24, 26-29, 35, 39, 43, 45, 47 and  
52-60 are withdrawn from further consideration pursuant to 37 CFR  
1.142(b), as being drawn to nonelected inventions. Applicant timely  
traversed the restriction (election) requirement in Paper No. 10.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, "carbonyl" is misspelled (page 214, line 12). Claim 41 lacks antecedent basis from claim 1 because of the R<sup>12</sup> substituent -N<sup>+</sup>(O<sup>-</sup>)NR<sup>13</sup>R<sup>14</sup>.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8, 10, 11, 25, 30, 33, 36, 40, 46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. {U.S. Pat. 6,130,239}.

***Determination of the scope and content of the prior art (MPEP §2141.01)***

Applicants claim aryloxindoles. Chen et al. teach aryloxindoles which are structurally similar to the instant claimed products. See in the reference, for example, Formula II in claim 34 (column 129) wherein b is a heterocycle, R<sup>2</sup> is halogen, R<sup>3</sup> is alkyl, X is =CR<sup>5</sup>, R<sup>5</sup> is -CONR<sup>8</sup>R<sup>9</sup>, R<sup>9</sup> is hydrogen, R<sup>8</sup> is an alkyl substituted with NR<sup>9</sup>R<sup>10</sup> and R<sup>9</sup> and R<sup>10</sup> are each alkyl (columns 129-131 and column 2, lines 19-28) or see Example 127B in column 114.

***Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)***

The difference between the products of the prior art and the products instantly claimed is that of generic description.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. an anti-tumor agent). One skilled in the art would thus be motivated to prepare products embraced by the reference genera to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating tumors. Therefore, the instant claimed products would have been suggested to one skilled in the art.

The elected species is free of the art of record because the prior art fails to teach or suggest a hydrogen at the 4-position of the oxindole ring and a substituted amino-alkyl-carboxamide group at the 4-position of the pyrrole ring.

*Allowable Subject Matter*

Claims 3-7, 13, 17-19, 31, 32, 34, 37, 38, 42, 44, 48, 49 and 51 are objected to: (1) as being dependent upon a rejected base claim; and (2) for containing non-elected subject matter (see above generic concept) but would be allowable over the art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

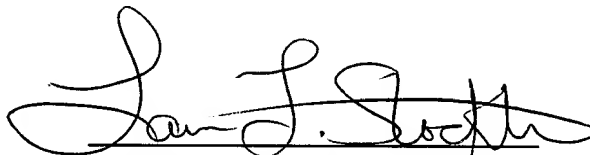
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.



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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

April 19, 2002